

REMARKS**Rejection of Claims of Art Grounds in the 11 November 2004 Office Action, and Traversal Thereof**

In the 11 November 2004 Office Action, claims 1, 3-5, 7-10 and 12-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., "Managing the software design documents with XML", Proceedings of the 16th annual international conference on Computer documentation, September 1998 (hereafter Suzuki) in view of Chao et al., US Patent No. 6,711,299 (hereinafter Chao). The above rejections of the claims 1, 3-5, 7-10 and 12-21 are traversed, and consideration of the patentability of claims 1, 3-5, 7-10 and 12-21, as amended, is requested in light of the ensuing remarks.

The Present Invention Is Not Obvious Over The Cited References

A claimed invention may be found to have been obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Moreover, the Federal Circuit has ruled on numerous occasions that a holding of "obviousness" requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify the cited reference or references as claimed by applicant. See, for example, *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re*

Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited Suzuki reference and the cited Chao patent describe software tools. The claims of the present application also describe a software tool. The invention described by Suzuki pertains to the management of software design tools using XML. On the other hand, the Chao patent discloses a software tool for compressing image files using a wavelet-based transformation. The present invention also discloses a software tool. However, the software tool of the present invention as specifically claimed is novel and non-obvious over the cited references.

The Applicant asserts the Examiner's position that Chao teaches "generating hyperlink references from the regions of the image map of the diagram to the textual documentation" is improperly made in hindsight. For one, Chao only discloses assigning hyperlinks to areas of a compressed image. Secondly, Chao is embedding the hyperlinks in source code rather than providing hyperlink references in the diagram that link diagram elements to the corresponding portions of the textual documentation as is required by independent claims 1, 4, 5 and 21. There is no suggestion or teaching within either Suzuki or Chao that would lead one skilled in the art to modify the cited references to include a step of providing hyperlink references in the diagram that link diagram elements to the corresponding portions of the textual documentation.

Independent claim 8 is currently amended to include the limitation of having hypertext markup language (HTML) links between the diagram portion and the text portion. There is no suggestion or teaching within either Suzuki or Chao that would lead one skilled in the art to modify the cited references to include the limitation of having hypertext markup language

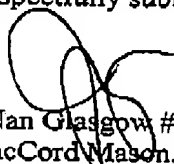
(HTML) links between the diagram portion and the text portion. This limitation is taken from claim 10 as original. Therefore, no new matter has been added by this amendment.

CONCLUSION

In view of the foregoing, claims 1, 3-5, 7-10 and 12-21 constituting the claims pending in the application, are submitted to be fully patentable and in allowable condition to address and overcome the rejections.

If any issues remain outstanding, incident to the allowance of the application, Examiner Tang is respectfully requested to contact the undersigned attorney at (919)-664-8222 or via email at jnang@trianglepatents.com to discuss the resolution of such issues, in order that prosecution of the application may be concluded favorably to the applicant.

Respectfully submitted,

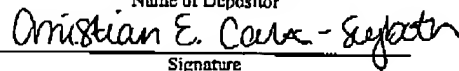

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Name of Depositor


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